

PATENT

App. Ser. No.: 09/882,917

Atty. Dkt. No. ROC920010074US1

PS Ref. No.: IBMK10074

REMARKS

This is intended as a full and complete response to the Final Office Action dated August 19, 2005, having a shortened statutory period for response set to expire on November 19, 2005. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-26 are pending in the application. Claims 1-26 remain pending following entry of this response.

Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 6, 10-13, 15, 18-23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 6,044,387 issued to *Angiulo et al.* (hereafter *Angiulo*). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In this case, *Angiulo* does not disclose "each and every element as set forth in the claim", as described below.

With respect to claim 1, and the claims that depend therefrom, *Angiulo* does not disclose "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames". The Examiner argues that *Angiulo* discloses automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames at Fig 3, Item 110 and Col. 5, Lines 27-43. However, the cited sections are in fact directed to

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checking the spelling of pages in an editor, as clearly indicated by both the title of the dialog box 100 in Fig. 3 and the cited text in Col. 5. The cited section states that the user may check the spelling of all pages on a website or only selected pages. See Fig 3; Col. 5, Lines 27-43. The section does not describe frames, does not state that the pages being checked for spelling are frames, nor does the cited section mention searching. Thus, the cited section does not describe automatically designating one of at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames.

With respect to claims 10 and 21, and the claims that depend therefrom, *Angiulo* does not disclose "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame". The Examiner argues that *Angiulo* discloses automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame at Fig 9, Steps 192, 196 and 198 and Col 9, Lines 15-25. However, the cited passage is in fact directed to logic implemented when carrying out an editing operation. See Col. 8, Lines 64-66. The editing operation can be either a spell check of documents or a find/replace operation. See Col. 8, Line 66 – Col. 9, Line 2. If the user elects to conduct an editing operation on all files on the web, a list of all of the files on the web site is built. See Fig. 9, Item 192; Col. 9, Lines 2-10. A counter or variable 'n' is then initialized to 0, and the editing operation is performed beginning with file 'n'. See Fig. 9, Items 190, 192, 194, 196, 198, 200; Col. 9 Lines 12-18. The cited figure and section do not describe that the documents being edited are frames. See *id.* Furthermore, because the cited section does not describe that the documents being edited are frames, the cited section does not describe a designation of a default search frame. See *id.* Accordingly, the reference does not describe "automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame". Withdrawal of the rejection is respectfully requested.

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Claim Rejections - 35 U.S.C. § 103

Claims 5, 7, 14 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,909,837 issued to *Unger*. Also, claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 6,658,626 as issued to *Aiken*. Claims 9, 17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Angiulo* in view of US Pat No 5,388,993 issued to *McKiel et al.* (hereinafter *McKiel*). Applicants respectfully submit that the rejection with respect to *Angiulo* has been overcome as described above. Therefore, withdrawal of the rejection is respectfully requested.

Furthermore, with respect to claims 25 and 21, the Examiner states that "the combination of *Gamon* and *Angiulo* discloses the elements of claim 21" and that "the skilled artisan would have been motivated to improve the invention of the combination of *Gamon* and *Angiulo*". However, as stated in the previous response from Applicants (dated July 15, 2005), *Gamon* and the present invention, at the time the present application was made, were owned by the same entity, or subject to an obligation of assignment to the same entity, as shown in a Statement of Common Ownership submitted July 15, 2005. Under 35 U.S.C. § 103(c), the Statement of Common Ownership removes *Gamon* as a reference under 35 U.S.C. § 102(e). Therefore, Applicant respectfully requests that the rejection be withdrawn.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Grounds for Finality of the Rejection

In the Examiner's conclusion, the Examiner states that "Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. Sec. 103(c) on 7/15/2005 prompted the new ground(s) of rejection under 37 CFR 1.109(b)". The Examiner further states that prompted a new grounds of rejection under 37 CFR Sec. 1.109(b), which refers to double patenting rejections. Applicants have neither filed a statement describing a joint research agreement, nor has the Examiner provided a double patenting rejection. Accordingly, Applicants respectfully submit that

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the stated ground for making the action final is improper. Accordingly, Applicants respectfully request that the "final" designation of the rejection of the application be withdrawn.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner believes any issues remain that prevent this application from going to issue, the Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance.

Respectfully submitted,



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